

Atty Dkt. No.: 10003516-1
USSN: 09/938,937

REMARKS

The Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Formal Matters

This response accompanies a Request for Continued Examination.

Entry of the claim amendments made in the Applicants response of May 7, 2007, is respectfully requested.

As best understood from the Advisory Action of May 23, 2007, the outstanding rejections in this case are predicated upon entry of non-entered amendments. In view of the RCE, the Applicants request full consideration of their prior arguments, as outlined in their response of May 7, 2007.

New matter

In the Advisory Action, the Examiner argues that the proposed claim amendment relating to "spatially addressed" appears to introduce new matter.

However, the written description requirement of 35 U.S.C. § 112, first paragraph, involves the question of whether the subject matter of a claim conforms to the disclosure of an application as filed. According to the MPEP, an objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed?"¹ The subject matter of the claim need not be described literally (i.e. using the same terms or *in haec verba*) in order for the disclosure to satisfy the written description requirement. Likewise, MPEP states that newly added claim limitations may be supported by disclosure that is express, implicit, or inherent.²

¹ See MPEP § 2163.02, citing *In re Gosteli* 872 F.2d 1008, 1012 (Fed. Cir. 1989).

² MPEP § 2163: "The written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims, which introduce elements or limitations, which are not supported by the as-filed

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In attempting to establish this rejection the Examiner argues that a "spatially addressed" array is not described in the specification as filed.

The Applicants submit, however, that spatially addressed arrays are described in the specification on page 19, lines 1-5. Likewise, it is spatially addressing is an implicit feature of polynucleotide arrays, which are specifically mentioned throughout the disclosure. Since support for a claim may be express, implicit or inherent, and need not be *in haec verba*, the Applicants submit that the claims are adequately described.

The Examiner appears to be seeking explicit support for the term "spatially addressed". However, the MPEP makes it very clear that support for a claim need not be explicit.

In view of the foregoing discussion, the Applicants submit that the current claims recite subject matter that is no broader than as described in the specification as originally filed. As such, the Applicants believe that the written description requirement of 35 U.S.C. § 112, first paragraph, has been satisfied, and no new matter is added.

Withdrawal of this rejection is requested.

disclosure, violate the written description requirement... While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. (emphasis added)

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Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone James Keddie at (650) 833-7723.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10003516-1.

Respectfully submitted,

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